

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed September 4, 2008 and offers the following remarks to accompany the above amendments.

### ***Status of the Claims***

Claims 38-57 were previously pending. Applicant has cancelled claims 38, 48, and 54. Applicant has rewritten claims 39, 49, and 55 in independent form, amended claims 40-47 to now depend from claim 39, amended claims 50-53 to now depend from claim 49, and amended claims 56 and 57 to now depend from claim 55.

Note that while claims 40-47 have been amended to now depend from claim 39, Applicant reserves the right to submit and argue independent claims directed to the subject matter of claims 40-47 as they were when they depended from claim 38. Likewise, while claims 50-53 have been amended to now depend from claim 49, Applicant reserves the right to submit and argue independent claims directed to the subject matter of claims 50-53 as they were when they depended from claim 48. Lastly, while claims 56 and 57 have been amended to now depend from claim 55, Applicant reserves the right to submit and argue independent claims directed to the subject matter of claims 56 and 57 as they were when they depended from claim 54.

### ***Claim Rejection – 35 U.S.C. § 101***

Claims 54-57 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses. In rejecting claims 54-57, the Patent Office stated that “signal claims are ineligible for patent protection because they do not fall within the four statutory classes of § 101” and referred to the November 22, 2005 OG Notice entitled “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.”<sup>1</sup> However, the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility clearly state that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. (Citing *In re Lowry*, 32

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<sup>1</sup> Office Action mailed September 4, 2008, p. 2.

F.3d 1579, at 1583-84). Further, recently in *Ex parte Bo Li*, Appeal 2008-1213 (BPAI 2008), the Board of Patent Appeals and Interferences found that Beauregard claims, such as claims 54-57, are statutory product claims under 35 U.S.C. § 101. As such, Applicant requests that the rejection of claims 54-57 under 35 U.S.C. § 101 be withdrawn.

***Claim Rejection – 35 U.S.C. § 102(e)***

Claims 38, 39, 41, 43-46, 48, 49, 52-55, and 57 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0010759 A1 to Hitson et al. (hereinafter “Hitson”). Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. M.P.E.P. § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case with respect to claims 39, 41, 43-46, 49, 52, 53, 55, and 57. Applicant has cancelled claims 38, 48, and 54 and rewritten claims 39, 49, and 55 in independent format.

Regarding claim 39, Hitson fails to disclose: (1) maintaining a user listening history comprising a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device and (2) automatically selecting a plurality of broadcast elements based on a user profile of a user and the user listening history. In rejecting claim 39, the Patent Office referred to paragraphs 139 and 151 of Hitson.<sup>2</sup> Paragraph 139 of Hitson discloses that user feedback from a user is matched to a previous playlist transmitted to the user and then used to adjust content genre preferences used to select content for new playlists for the user. Paragraph 151 of Hitson discloses that a user may rate previously experienced content and that those ratings may be used when selecting content for the user or a group of users. Thus, paragraphs 139 and 151 of Hitson disclose using user feedback and user ratings regarding previous content transmitted to the user when selecting new content for the user. However, paragraphs 139 and 151 of Hitson fail to disclose that a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device (rather than user feedback or user ratings regarding those broadcast elements) is used to automatically select a plurality of broadcast elements to transmit to the user device. As such, claim 39 is allowable.

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<sup>2</sup> *Id.* at p. 4.

Claim 41 is a dependent claim based upon claim 39. As such, claim 41 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claim 41 in the future, if needed.

Regarding claim 43, Hitson fails to disclose that the user profile includes information indicating a preference of a frequency of selection and transmission of a plurality of types of broadcast elements. As an example, as described on page 15, line 23 through page 16, line 2 of Applicant's specification, the user's profile may indicate that songs are to be played N times an hour and advertisements are to be played M times an hour. In rejecting claim 43, the Patent Office referred to paragraph 151 of Hitson.<sup>3</sup> However, in paragraph 151, Hitson states that "[u]sers may also rate individual content while content is experienced, and users may rate previously experienced content" (emphasis added). Paragraph 151 of Hitson then goes on to state that "[u]ser ratings may include an option to restrict the frequency with which content appears on a playlist." Thus, Hitson discloses that a user rating for an individual content item (e.g., a song) may include an option to restrict the frequency with which that individual content item appears on a playlist. While Hitson discloses that the frequency with which an individual content item appears in the playlist may be controlled by the user, Hitson fails to disclose that the user preference of the user includes a preference of a frequency of selection and transmission of a plurality of types of broadcast elements (e.g., songs, advertisements, etc). As such, claim 43 is allowable.

Regarding claim 44, Hitson fails to disclose that the plurality of broadcast elements further comprise a personalized broadcast element that includes a reference to a name of the user associated with the user device. For example, as described on page 12, lines 15-16 of Applicant's specification, the broadcast elements selected for, and transmitted to, the user may include audio elements, such as jingles, that know and use the user's name (e.g., "Hey Fred, this is your radio station," or "Its time for Fred's stocks"). In rejecting claim 44, the Patent Office referred to paragraphs 75, 76, 61, 69, and 70 of Hitson.<sup>4</sup> However, nowhere in the referenced paragraphs of Hitson or any other part of Hitson is it disclosed that the playlist created for and transmitted to the user includes a broadcast element that includes a reference to a name of the user. As such, claim 44 is allowable.

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<sup>3</sup> *Ibid.*

<sup>4</sup> *Ibid.*

Claims 45 and 46 are dependent claims based upon claim 39. As such, claims 45 and 46 are allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claims 45 and 46 in the future, if needed.

Claim 49 is an apparatus claim that substantially corresponds to claim 39. As such, claim 49 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claim 49 in the future, if needed.

Claims 52 and 53 are dependent claims based upon claim 49. In addition, claims 52 and 53 include subject matter substantially similar to that in claims 43 and 44, respectively. As such, in addition to being allowable for at least the same reasons set forth above with respect to claim 49, claims 52 and 53 are allowable for the reasons set forth above with respect to claims 43 and 44. However, Applicant reserves the right to further address the rejection of claims 52 and 53 in the future, if needed.

Claim 55 is a computer-usable medium claim that substantially corresponds to claim 39. As such, claim 55 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claim 55 in the future, if needed.

Claim 57 is a dependent claim based upon claim 55. As such, claim 57 is allowable for at least the same reasons set forth above with respect to claim 55. However, Applicant reserves the right to further address the rejection of claim 57 in the future, if needed.

#### ***Claim Rejection – 35 U.S.C. § 103(a) – Hitson and Rosenberg***

Claims 40, 42, 50, 51, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitson in view of U.S. Patent No. 7,028,082 B1 to Rosenberg et al. (hereinafter “Rosenberg”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. M.P.E.P. § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Claim 40 is a dependent claim based upon claim 39. As such, claim 40 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claim 40 in the future, if needed.

Regarding claim 42, the combination of Hitson and Rosenberg fails to teach or suggest at least: (1) halting transmission of one of the plurality of broadcast elements to the user device prior to completion of the transmission of the one of the plurality of broadcast elements and (2) transmitting the alert broadcast element to the user device while the transmission of the one of the plurality of broadcast elements is halted. In rejecting claim 42, the Patent Office admitted that Hitson fails to teach the elements of claim 42 and therefore relied on column 4, line 63 through column 5, line 3 of Rosenberg.<sup>5</sup> The cited portion of Rosenberg teaches a personalized audio channel that may include a combination of songs and information, where the information may be stock quotes, sports news, weather information, etc. However, Rosenberg fails to teach or suggests halting transmission of a broadcast element (e.g., a song or an advertisement) and transmitting an alert broadcast while the broadcast element is halted. In contrast, in Rosenberg, the songs and information are played sequentially in the audio channel (e.g., song 1, song 2, sports news, song 3, song 4, weather information, ...). Rosenberg fails to teach, for example, halting transmission of song 1 before transmission of song 1 is complete and transmitting an alert while transmission of song 1 is halted. As such, claim 42 is allowable.

Claim 50 is a dependent claim based upon claim 49. As such, claim 50 is allowable for at least the same reasons set forth above with respect to claim 49. However, Applicant reserves the right to further address the rejection of claim 50 in the future, if needed.

Claim 51 is a dependent claim based upon claim 49 that is substantially similar to claim 42. As such, in addition to the reasons set forth above with respect to claim 49, claim 51 is also allowable for the reasons set forth above with respect to claim 42. However, Applicant reserves the right to further address the rejection of claim 51 in the future, if needed.

Claim 56 is a dependent claim based upon claim 55. As such, claim 56 is allowable for at least the same reasons set forth above with respect to claim 55. However, Applicant reserves the right to further address the rejection of claim 56 in the future, if needed.

#### ***Claim Rejection – 35 U.S.C. § 103(a) – Hitson and Mackintosh***

Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitson in view of U.S. Patent No. 6,317,784 B1 to Mackintosh et al. (hereinafter “Mackintosh”). Applicant respectfully traverses. Claim 47 is a dependent claim based upon claim 39. As such,

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<sup>5</sup> *Id.* at p. 6.

claim 47 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicant reserves the right to further address the rejection of claim 47 in the future, if needed.

***Conclusion***

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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